

Attorney Docket No.: RU-0195
Inventors: Williams, Lawrence Joseph
Serial No.: 10/807,206
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REMARKS

Claim 1 is pending in the instant application. Claim 1 has been rejected. Claim 1 has been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

I. Rejection of Claims Under 35 U.S.C. §102

Claim 1 has been rejected under 35 U.S.C. §102 as being anticipated by Chu et al. (U.S. Patent No. 4,859,776). It is suggested the Chu et al. teach a process of producing an amide comprising a thio acid and an organic azide in the presence of a solvent (columns 9-10 and Table II) thereby anticipating the instant invention.

Applicant respectfully disagrees with this rejection. Chu et al. teach that an azide can be directly converted to an acetamide by reacting the azide with thiolacetic acid (see paragraph bridging columns 5 and 6). This reference exemplifies this reaction by combining an azide with thiolacetic acid in the absence of a solvent (see Example 1 part (c) and Examples 5-7). In contrast, the instant application teaches combining a thio acid and an organic azide in the presence of a solvent to form a dilute solution (e.g., a ratio of 1:1.0-6.0 azide:solvent) so that an amide is produced (see page 7, lines 16-18, and page 8, lines 21-24). In the instant method the thio acid is not used as a solvent or co-solvent, i.e., the solvent is a separate component of the reaction (see page 7, lines 18-19). Applicant has appreciated that while water, methanol and other solvents are poor solvents for amine reactions, these

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solvents are compatible with the instant amidation reaction. In an earnest effort to highlight these novel features of the instant method, Applicant has amended claim 1 to indicate that the thio acid and azide are combined in the presence of a solvent, wherein the solvent is not the thio acid and the solvent is employed at a ratio of 1:1.0-6.0 azide:solvent. Support for this amendment can be found at page 7, lines 16-19, and page 8, lines 21-24. Because Chu et al. fail to teach or suggest the claimed reaction components at the recited ratios, this reference fails to anticipate the instant invention. It is therefore respectfully requested that this rejection be reconsidered and withdrawn.

II. Rejection of Claims Under 35 U.S.C. §103

Claim 1 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Chu et al. in view of Fazio et al. ((December 2003) *Tetrahedron Letters* 44:9083-9085). It is suggested that Chu et al. teach a process of producing an amide comprising a thio acid and an organic azide, wherein the difference between Chu et al. and instant process is that the Chu et al do not use the word solvent. It is suggested that thioacetic acid is a well-known solvent as disclosed by Fazio et al. and that it would have been obvious to one of skill in the art at the time the invention was made to modify the process of Chu et al. by including a solvent other than thioacetic acid, because Fazio et al. expressly teaches that the use of solvent is old in the process of making an amide starting from an azido and thioacetic acid. Applicant respectfully traverses this rejection.

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At the outset, Applicant respectfully wishes to point out that the instant invention was made prior to the publication date of Fazio et al., as evidenced by Shangguan et al. ((2003) J. Am. Chem. Society 125:7754-7755), Applicant's own publication published within the one year grace period allowed under 35 U.S.C. §102(b). A 1.132 Declaration by Dr. Lawrence J. Williams, submitted herewith, affirms that Shangguan et al. is Applicant's own publication which is not by another nor published more than twelve months prior to the present application. Therefore, Fazio et al. is not prior art under 35 U.S.C. §102(b), and thus §103, which entitles a person to a patent unless the invention is patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. MPEP 2133. Because Chu et al. fail to teach or suggest all the claim limitations and Fazio et al. is not a prior art reference, the instant invention is not obvious in view of these references. MPEP 2142. It is therefore respectfully requested that this rejection be withdrawn.

III. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

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favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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